

REMARKS

Pursuant to 37 C.F.R. §1.111, reconsideration of the instant application, as amended herewith, is respectfully requested. Entry of the amendment is requested.

Claims 1-61 are presently pending before the Office, with claims 11-32, 43-55, 57, 58 and 60-61 being withdrawn due to a restriction requirement. No claims have been canceled. Applicant has amended the specification. No new matter has been added. Applicant is not intending in any manner to narrow the scope of the originally filed claims.

Applicant thanks the Examiner for the interview of October 20, 2004. Applicant believes that the Examiner was satisfied with responses to his questions during the interview. Applicant request that the Examiner call the undersigned for any additional amendments that will advance the case to allowance.

The Examiner's Action mailed August 30, 2004 has been carefully studied by Applicant and the undersigned counsel. The amendments appearing herein and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is believed to be in condition for allowance.

The Examiner has rejected the claims under 35 U.S.C. §112, first paragraph. The Examiner effectively alleges that the specification fails to provide an adequate written description of the invention and fails to adequately teach how to make and/or use the invention, i.e., fails to provide an enabling disclosure. In particular, the Examiner alleges that the *se* of the term

"magnecules" has no independent verification and that the alleged increase of mass and energy content is contrary to the laws of thermodynamics. Applicant respectfully traverses the rejection.

First, regardless of how much disclosure is included in the specification, the Examiner should note that the claims are directed to specific arrangement or combination of components to accomplish specific features in the form of an apparatus. The gas or forms of gases are not being claimed. Further, applicant has a right to use his own terms as long as he defines what he means by those terms so one skilled in the art can understand what the objective of the inventor is.

What is being produced by the claimed apparatus and its associated method is a form of gas such as hydrogen fuel or oxygen. The hydrogen fuel and oxygen produced are the same hydrogen and oxygen as is currently understood in chemistry, except that the atoms, dimers, etc., have been subjected to conditions, such as extremely intense compression (pressurization) and magnetic fields, which creates a magnetic characteristic to the atoms and gases that effectively results in a processed gas with a higher density. This higher density provides for higher energy content than the same gas before it has been processed, that is, entropy increases with the increase in density. Contrary to the Examiner's assumption, no where in the specification does applicant claim that mass is increased. The conservation of mass law is still applicable.

In essence, the Examiner has intertwined DENSITY into MASS, resulting in the belief that the claims of the instant application is an apparatus that increases the mass, thus violating physical laws.

As mentioned above, this application deals solely with an apparatus and a method for the increase of the DENSITY under the strict conservation of the mass, which conservation was not stated in the specification because it is so obvious to anybody skilled in the art.

For instance, the application deals with an equipment capable of turning 2 standard cubic feet (scf, that is, cf at atmospheric pressure) of hydrogen into 1 scf, thus resulting in the doubling of the density, with the evident conservation of the mass, that is, the initial mass of 2 scf is now possessed in the final scf. Mass is established by the H atoms and this application considers no possibility for their change.

In regard to the conservation of ENERGY, the examiner is equally strayed well off the intended scope of the invention because the scientific reality is exactly the opposite of what is stated. In fact, the lack of increase of the energy content measured in BTU/scf or other units whenever we increase the density would cause indeed a violation of the conservation of the energy.

Specifically, conventional H₂ contains 300 BTU/scf. When 2 scf of hydrogen are turned into 1 scf with double density and the same mass, the energy content of the latter must double and become 600 BTU/"new" scf because, in the event the BTU/scf of the latter were only 300, we would have violated the conservation of the energy by somehow losing 300 BTU.

The examiner then talks about thermodynamics. It is easy to see that entropy increases with the increase of the density. Therefore, Applicant submits that he just does not understand or see where the violation of the laws of nature might remotely be.

Applicant is not persuaded that those skilled in the art cannot define or determine the metes and bounds of Applicant's invention.

Satisfaction of the enablement requirement, of course, is a question of law. To provide answers to this question, the disclosure is analyzed on a "how to make" criteria and on a "how to use" criteria. Clearly, the how to make and use criteria are met as the

apparatus and method is well described in the specification and drawings. In fact, one need not even understand the chemistry as to what is happening during the processing or use of the apparatus, one need only understand how to assemble the apparatus and use it. A manufacturer is only interested in the performance outcome of the produced gas. In a related technology for the production of hydrogen using electrolyzers, one President and CEO and inventor of a motor manufacturer in Ohio was quoted in the Toledo Blade newspaper at a Governor's conference as saying he did not know how or why the invention worked but the fact is, is that it does work. The same essentially applies in the instant case, one need not be a post-PhD to be considered one skilled in the art to practice the invention. One need only be an engineer and trades man who knows how to build and assemble such apparatus, and in turn operate it.

Applicant has clearly set forth a concise disclosure on how to make the invention. See pages 13-25 of the Specification. Applicant also has clearly demonstrated how to use the invention. No authority has been cited to indicate that any of the specific claimed embodiments could not be made or could not be used as taught by Applicant. In short, there is no reasonable basis for doubting that Applicant's claimed invention could be made and/or used.

In particular, those skilled in the art would not find the invention as claimed to be unduly broad in the context of the Specification. Claims certainly would not be read to cover inoperative embodiments.

As mentioned above, Applicant respectfully submits that the broad scope is supported by the specification. The claims provide a clear warning to others as to what will constitute infringement. The standard of review is the rule of reason.

The Federal Circuit stated the standard for determining compliance with the written description requirement as follows:

Although the applicant does not have to describe exactly the subject matter claimed, the description must clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed. The test for sufficiently of support . . . is whether the disclosure of the application reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.

Vas-Cath, Inc., v., Mahurkar, 935 F.2d 1595, 19 U.S.P.Q.2d 1111 (Fed. Cir. 1991). For purposes of this inquiry, the invention is whatever is claimed.

Further, it should be noted that the enablement requirement under Section 112 may also be satisfied even if a person of ordinary skill in the art must conduct a certain, limited degree of experimentation in order to reproduce the invention. This principle is uniformly recognized by all courts dealing with patent matters.

In Moba B.V. v. Diamond Automation, Inc., 66 USPQ2d 1429-1444 (Fed. Cir. 2003), the Federal Circuit stated that compliance with the written description requirement of 35 USC 112 does not require a particular form of disclosure, provided a person skilled in the art can determine from the specification that the inventor possessed the invention at the time of filing. In this case, the patent for an egg sorting method did not need to disclose the conveyor lifting system encompassed by the asserted claims, since the specification described **every element of the claim in sufficient detail** that one of ordinary skill in the art would recognize that the inventor possessed the invention at the time of filing.

Certainly, one need not know the chemistry in the instant case, as long as each element claimed in the apparatus and method claims are disclosed.

By way of emphasis, the courts have also consistently held that the disclosure of invention set forth by an Applicant must be given a presumption of correctness and operativeness by the Office and that the only relevant concern of the Office should concern the truth of the assertions contained in the disclosure. The court in In re Marzocchi, 439 F.2d 220, 169 U.S.P.Q. 367 (C.C.P.A. 1967) states this principle with clarity:

As a matter of Patent Office practice, then, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented **must** be taken as in compliance with the enabling requirement of the first paragraph of §112 **unless** there is a reason to doubt the objective truth of the statement contained therein which must be relied on for enabling support . . . In any event, it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain **why** it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

In this case, the Examiner is merely asserting a general rejection based as contrary to known principles of natural law based in erroneous assumptions of what Applicant is asserting and without any evidence to show that the density can not be increased in the newly formed gas and why entropy can not be increased in the newly formed gas. Applicant submits that the Examiner is being influenced by other personnel in the group involved with applicant's co-pending applications, where denials are being given without any consideration for the data provided by applicant as to the existence of the magnecular characteristic of the processed gases.

Applicant respectfully submits that the language and format of the claims render the Examiner's rejection baseless as Applicant is not claiming that mass is increased. To the contrary, Applicant agrees that the conservation of mass and energy still applies. Accordingly, in

view of the arguments, Applicant respectfully requests that the Examiner withdraw the objection to the specification and the rejection of the claims under 35 U.S.C. §112, first paragraph.

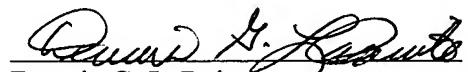
CONCLUSION

A Notice of Allowance is earnestly solicited.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 538-3800 would be appreciated.

Very respectfully,

Dated: 10/20/04


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